

REMARKS

The Examiner's listing of the claims readable on the elected species is accepted by the Applicant, except that it is believed the Examiner may have inadvertently left claim 11 off the listed claims. It is believed that claim 11 can also be examined with the claims readable on the elected species. All the remaining claims are either withdrawn or have been canceled. Applicant reserves the right to file divisional applications on the claims to the non-elected species.

Claims have been amended to overcome the objections under 35 U.S.C. § 112 raised by the Examiner. Accordingly, the Examiner is respectfully requested to withdraw this objection to the elected claims as now listed.

Further, claim 61 has been amended to overcome the objection under 35 CFR 1.75(c) that it is dependent on a multiple dependent claim. Accordingly, the Examiner is respectfully requested to withdraw this objection with respect to claim 61.

Of the claims now remaining in the present application, claims 1, 4, 23, 43 and 57 are the only independent claims. All of the other remaining claims are dependent directly or indirectly on one or more of these independent claims. All of these independent claims and the claims dependent thereon have been amended as above indicated to overcome the objections raised by the Examiner and to distinguish these claims from the patent references cited and relied on by the Examiner. These independent claims and the claims dependent thereon as so amended will be addressed as if they were rejected on the same grounds as were set forth against these claims before they were so amended.

Thus, claims 1, 4, 23, 43 and 57 as amended and the claims dependent thereon as amended, have been rejected as anticipated under 35 U.S.C. §102(b) by at least one of several

cited patents, namely, U.S. Patent No. 2,562,519 to *Ashley*; U.S. Patent No. 3,760,994 to *Talmisto*; U.S. Patent No. 3,072,306 to *Macrides* and U.S. Patent No. 3,107,830 to *Teague*.

It is the Applicant's position that all of the independent claims 1, 4, 23, 43 and 57 as now amended are not anticipated by any one of these cited patents because the overall subject matter as now claimed in each of the independent claims as amended provides structural elements and an operative interrelation of these structural elements not shown or suggested in any one of these cited patents.

Thus, in claim 1 the Examiner will find the following structural and operatively related elements and limitations:

- a. said body having, a relatively wide center section,
- b. said center section having an attachment assembly for releasable engagement with the collar button,
- c. relatively wide and spaced side sections each respectively connected at an inner end to the center section and disposed to extend in opposite directions from the center section, and
- d. each of the side sections having a resilient holding member formed from, connected at its same inner end with and extending in the same direction from said inner connected end of its associated one of the said side sections to dispose in assembled position the free end of each respective holding member for operative association with the collar on the garment to hold the collar in position.

In claim 4, the following similar structural and operatively related elements:

- a. said body having a relatively wide center section,
- b. said center section having an attachment assembly formed therein for releasable engagement with the collar button,

c. relatively wide and spaced side sections each respectively connected at an inner end to the center section and disposed to extend in opposite directions from the center section to form a free end,

d. each of the respective side sections having a resilient holding member,

e. each resilient holding member is an elongated strip formed from and connected at its inner end with and extending in the same direction from the inner connected end of its associated one of the side sections, and

f. each said elongated strip having a free end remote from its said connected end disposed in assembled position on opposite sides of the center section to engage the outer face of the collar on the said garment.

Claim 23 covers the combination of a garment having a collar with a collar protector having the same structural and operatively related elements as above set forth for either claim 1 or claim 4.

In claim 43, a three-dimensional collar protector *per se* is claimed having the following structural and operatively related elements:

a. a generally unitary body made of polymer material,

b. said body having a relatively wide center section and spaced side sections each respectively connected at an inner end to the center section and disposed to extend in opposite directions from the center section,

c. said center section and a first portion of each of said side sections disposed in a first plane;

d. each of the side sections having a holding member formed from, connected at its same inner end with and having a free end extending in the same direction from said connected end of its associated one of the said side sections,

e. each of said holding members having a first portion disposed above said first plane, and

f. said holding members arranged for operative association with the collar on said garment to hold the collar in position.

And in claim 57, the following structural limitations:

a. a generally unitary body made of a resilient material having a center section and at least two spaced side sections,

b. said center section on the collar protector has an attachment assembly for releasably connecting the collar protector to the collar button on the collar in assembled position,

c. said spaced side sections each respectively connected at one end to the center section and disposed to extend in opposite directions from said center section,

d. said spaced side sections having at least one first arm thereon extending from said center section and in assembled position disposed for engagement with the inner face of the collar, and

e. said spaced side sections having at least one second arm thereon disposed for engagement with the outer face of the collar to releasably hold the collar protector in assembled position.

Referring now to the said patents cited and relied on by the Examiner in support of the rejection of these independent claims, as amended, Pat '519 discloses a collar protector made of a single length of resilient wire bent into and inverted U-shape to produce a cross bar 2. Crossbar 2 has a centrally disposed attaching section 5. Spaced arms 3-3 are disposed at and depend from the respective opposite ends of the cross bar remote from the centrally disposed attaching section 5. The depending and spaced arms 3-3 are integral with the cross bar 2

and do not have an inner end connected to the center attaching section 5. Neither the cross bar 2 nor the respective depending and spaced arms 3-3 have holding members respectively formed therefrom, connected at their inner ends to the centrally disposed attachment assembly and having free ends which are operatively connected to the outer surface of the collar in assembled position. Further, all the independent claims as now amended require a relatively wide center attaching section and corresponding relatively wide spaced side sections which are clearly distinguishable from the wire protector shown and disposed in Pat '519.

Accordingly, claims 1, 4, 23, 43 and 57 as amended are thought to be clearly distinguishable from Pat '519, and these claims are therefore not anticipated by this patent.

Pat '994 discloses a collar protector made of a single curved unit of plastic material M having a central planar attaching section T with an attaching means H. Spaced side sections K-K are formed and connected respectively on opposite sides of the central plan attaching section T. The side sections are formed as hemi-spherical bosses or domes referred to in this patent as "Bubbles." The side sections K-K do not have or need holding members because in assembled position as stated at column 2, lines 37 to 39 in Pat '994 --The highest elevation of the bubbles K is thus adapted to support the tip portion of the shirt collar from beneath.-- (underlining added for emphasis)

Accordingly, claims 1, 4, 23, 43 and 57 as amended are thought to be clearly distinguishable from Pat '994, and these claims are therefore not anticipated by this patent.

Pat '306 discloses another device for use on the collar of a garment in a display. It is not intended for or used as a collar protector. The Pat '306 device used for a display is made of a single piece of plastic material having a

central attaching section with a securing means 11. Extending from opposite sides of the central attaching section are spaced side sections 12 and 13. The spaced side sections do not have or require separate and independent resilient holding members formed from, connected at their inner ends with and having free ends extending in the same direction as the respective associated one of said side sections as called for in Applicant's enumerated independent claims as amended. The side sections shown in Pat '305 have at the respective outer or free ends rolled or scrolled sections as at 14 and 15 which, in assembled position, provide a resilience to resist crushing and a full surface support for the roll area of the cape position of the collar to maintain a pleasing natural roll in the cape position when the garment is displayed for sale to customers. See column 2, line 72 to column 32, lines 1 to 3 in Pat '306.

Accordingly, for the same reasons as above set forth for Pats '519, '594 and '306, claims 1, 4, 23, 43 and 57 as amended are thought to be clearly distinguishable from Pat '306, and these claims are therefore not anticipated by this patent.

Pat '830 discloses a collar protector for a laundered shirt. It does not disclose a collar protector which is adapted for other uses, such as dress wear. Thus, the disclosed collar protector in Pat '830 does not have any central attaching section with means for affixing the collar protector to a collar button associated with the conventional collar on a garment.

Accordingly, claims 1, 4, 23, 43 and 57 as amended are thought to be clearly distinguishable from Pat '830, and these claims are therefore not anticipated by this patent.

These independent claims as amended have been particularly noted because if these claims as amended are now allowable, then the claims dependent thereon are also allowable because they not only contain the same limitations but additional structural and operatively related elements which

further distinguish them from the patents cited and relied on by the Examiner to support the grounds for rejecting the independent claims.

Originally presented claims 3, 10, 13, 14, 20, 21, 22, 25, 31, 43, 45 and 49 were rejected under 35 U.S.C. § 103(a) as obvious and hence unpatentable based on Pat '519 to *Ashley* in view of U.S. Patent No, 2,304,464 to *Manaster*.

Of these claims, claims 3, 10 and 13 as now amended are dependent directly or indirectly on independent claims 1 or 4, as now amended. Claims 14, 20, 21, 22 and 49 have been canceled. Claim 43 is also an independent claim which has been amended, and claim 45 is dependent on claim 43.

Accordingly, this ground for rejecting these claims as originally presented will be applied against these claims as now amended.

It is submitted that the independent claims 1, 4 and 43, as now amended, have been distinguished from Pat '519 to *Ashley*, the primary reference cited and relied on by the Examiner, for the reasons set forth above. The Examiner has cited Pat '464 to *Manaster* as a secondary reference to support the position that the collar protector disclosed in Pat '519 could be made of a plastic material not to otherwise change the structural elements of Pat '519 or their operative interrelation. Therefore, it is submitted that the Applicant's subject matter as claimed in claims 1, 4 and 43 is still clearly distinguishable because this combination of references fails to disclose a collar protector as claimed in the Applicant's independent claims 1, 4 and 43, for all of the same reasons as set forth.

These independent claims as amended and the claims dependent thereon as amended either directly or indirectly are not obvious in view of this combination of references and are therefore thought to be allowable.

In treating with obviousness as a ground for rejecting the patentability of claims, it is the responsibility of the Examiner to establish that the subject matter of a claim as a whole would have been obvious to a person of ordinary skill in the art. Thus, an analysis of a claimed invention by the parts, and not by the whole structure and operative interrelationship of the parts, cannot support a subjective conclusion by the Examiner that the subject matter would be obvious to a person of ordinary skill in the art. It has been held that it is impermissible within the framework and concept of § 103 to pick and choose from any reference, only so much of it as will support a given position by the Examiner or a challenger to the validity of a granted claim, to the exclusion of other parts necessary to the full appreciation of what such patent reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443; 230 U.S.P.Q. 416 (Fed. Cir. 1986); and *In re Hedges*, 783 F.2d 1038; 228 U.S.P.Q. 695 (Fed. Cir.1986) (bold and underlined portion added for emphasis)

This concept was nailed down by Congress at the time § 103 was enacted by the statutory phrase "as a whole." Thus, the difference of the claimed "subject matter as a whole" as distinguished from the parts or elements must be assessed to determine whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to show that the structure and operative interrelation of the elements in a given claim would be produced, achieved or obvious from the primary reference and/or any secondary references taken alone or in combination with each other.

Further, since the enactment of § 103, it has long been established law that the prior art references relied on by the Examiner must, when combined, show and suggest the structure claimed and the operative interrelation of the elements in order

to support a conclusion that the claimed subject matter "as a whole" is "obvious" and hence unpatentable.

Thus, *In Re Fritch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992), the court stated at page 1781 that:

--Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination under § 103, teachings of references can be combine *only* if there is some suggestion or incentive to do so.--

and

--The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless** the prior art suggested the desirability of the modification--. (bold and underlined word added for emphasis)

This general rule of law with respect to an obviousness type rejection has been set forth and reiterated in over twenty-five cases since the early case of *Ex parte Myerson*, 72 U.S.P.Q. 49, in which the then Honorable Board of Appeals held that:

--There is no basis for combination of references where nothing in either suggests modification of or use with the other. Combination was suggested by Applicant's disclosure; claims are allowed.--

See also the following early cases.

In re Billingsley (CCPA), 126 U.S.P.Q. 371

In re Bent (CCPA), 144 U.S.P.Q. 28

Ex parte Fleischmann, 157 U.S.P.Q. 155

Ex parte Westphalen, 159 U.S.P.Q. 507

In re Richman (CCPA), 165 U.S.P.Q. 509

All of the above law has also been noted because Applicant's attorney has also reviewed the patents of record and those cited and relied on by the Examiner. It is submitted in the light of the law as above set forth that these patents cannot be combined to render obvious Applicant's independent claims 1, 4, 23, 43 and 57, when they are considered --as a whole--, and these claims are therefore also thought to be allowable over any combinations of these patents either of record or cited by the Examiner.

Still further, if the Examiner finds that generic claims are allowable, for example, claim 1 or 4 is thought to cover all forms and species of the invention as shown and disclosed, the Examiner is respectfully requested to act on the claims which have not been elected and have been withdrawn.

Accordingly, having amended the claims now remaining in this application to overcome the objections raised by the Examiner and having distinguished these claims from the patents cited and relied on by the Examiner and in view of the cited law regarding the rejection based on "obviousness" under § 103(a), it is submitted that independent claims 1, 4, 23, 43 and 57 as now amended and all the claims dependent thereon either directly or indirectly, as now amended, are allowable. Reconsideration is earnestly solicited and an early notice of allowance respectfully requested.

As it is believed that all of the objections and rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he/she might have.

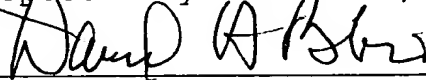
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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

Daniel H. Bobis

Registration No.: 16,694

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

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